

## **REMARKS**

This submission is in response to the Non-Final Office Action dated June 6, 2008.

Applicant has amended claims 1, 27, 28, and 56 to recite the invention with more particularity. Support for the amendments herein is found in the specification at least in paragraphs [0006] and [0021] in view of FIG. 3. Applicant respectfully submits that no new subject matter has been added via the amendments set forth herein.

Claims 1-9, 11-18, 20, 24-31, 33, 35, 36, 38, 40, 41, 43, 45, 47, 49-56, 61, 62, and 64-68 were rejected pursuant to 35 U.S.C. § 103(a), as unpatentable over Mustek (“Mustek, Attaching with Yahoo”) in view Eudora (“E-mail attachments in Eudora: How to be a Super Sender”). These rejections are respectfully traversed.

### Claims 1-9, 11-18, 20, 24-26, 61, 62, and 68

In traversing the rejection of independent claim 1, Applicant respectfully submits that the Mustek-Eudora combination fails to teach or suggest “a graphical user interface (GUI) ... comprising: a first user-selectable button having associated text that includes a verbal of “attach” ...; a list to display selected one or more files to attach ...; and a second user-selectable button having associated text that includes an imperative for “attach”, ... wherein the first user-selectable button, the list, and the second user-selectable button are presented together to the user in the GUI,” as particularly recited in claim 1. (Emphasis added).

Mustek discloses adding attachments to an email message. Mustek discloses presenting a “Compose Mail” screen as shown on page 2 of the reference, in which the user can click on a “Make an Attachment” button to initiate the process of adding attachments to the email message. After the “Make an Attachment” button is clicked, a separate “Attachment window” appears as shown on page 2 of the reference, through which the user can identify files to be attached. The user can click on an “Attach” button in the Attachment window to attach the files to the email message.

The Office asserts, in paragraph 3 of the Office Action, that the first user-selectable button recited in claim 1 is disclosed by the Mustek’s “Make an Attachment” button in the

“Compose Mail” screen, the list recited in claim 1 is disclosed by Attachments 1, 2, and 3 in Mustek’s Attachment window, and the second user-selectable button recited in claim 1 is disclosed by the Mustek’s “Attach” button in the Attachment window. Accepting the Office’s position for the sake of argument, Mustek nevertheless does not disclose wherein the first user-selectable button, the list, and the second user-selectable button are presented together to the user in the GUI, as particularly recited in claim 1. Mustek, by contrast, displays the “Make an Attachment” button in the “Compose Mail” screen, and subsequently displays Attachments 1, 2, and 3 and the “Attach” button in the separate Attachment window after the “Make an Attachment” button is clicked. There is no disclosure or suggestion of presenting the “Make an Attachment” button, Attachments 1, 2, and 3, and the “Attach” button together to the user in the GUI. Accordingly, Mustek does not disclose or suggest wherein the first user-selectable button, the list, and the second user-selectable button are presented together to the user in the GUI, as particularly recited in claim 1.

Eudora does not rectify this deficiency in Mustek. Eudora is directed to an email program enabling the sending of attachments with an email. To send an attachment with an email message, the user selects “Attach Document” from a message menu, which opens a dialog box. The user selects a file in the dialog box and clicks on the “Attach” button in the dialog box. The name of the document thereafter appears in the “X-Attachments” field in the email message header. (Eudora, pages 2-3). Eudora’s “Attach Document” and “Attach” buttons are not presented together to the user in the GUI. Moreover, Eudora does not disclose or suggest a list to display selected one or more files to attach. Eudora enables the user to select a file in a dialog box and upon the user clicking on the “Attach” button in the dialog box, the name of the selected file appears in the email message. Therefore, Eudora does not even suggest a list to display selected files to attach. Thus, Eudora does not disclose or suggest wherein the first user-selectable button, the list, and the second user-selectable button are presented together to the user in the GUI, as particularly recited in claim 1.

In view of the foregoing, Applicant respectfully requests the Examiner withdraw the rejection pursuant to 35 U.S.C. § 103(a) of independent claim 1. Applicant further respectfully requests the Examiner to withdraw the rejection of dependent claims 2-9, 11-18, 20, 24-26, 61,

62, and 68 based at least on their dependencies, whether direct or indirect, from the independent claim 1.

As to dependent claims 2-9 and 11-18, the Office has stated that “the claims are directed towards non-functional descriptive material and regardless of what the button actually reads the functionality of the button remains the same.” (Office Action, page 4). Applicant respectfully traverses these rejections. Claims 2-9 and 11-18 further define the text that includes a verbal for “attach” for the first user-selectable button of independent claim 1. As described in the specification, in accordance with various embodiments, the text for the first user-selectable button indicates the function of the button and why the user should select the button to avoid confusion for the user and make the user experience simpler and less error prone. (Specification, paragraphs [0008] and [0009]). The text thereby has a functional purpose, and since the text, as particularly defined in claims 2-9 and 11-18, is not shown in either Mustek or Eudora, these claims are patentable over the Mustek-Eudora combination for these additional reasons.

Claims 27, 64, and 65

In rejecting independent claim 27, the Office states (on page 5 of the Office Action) that “claims 27 and 28 are similar in scope to that of claim 1 and are therefore rejected under similar rationale.” Applicant traverses this rejection. The Mustek-Eudora combination fails to teach or suggest “a graphical user interface (GUI) ... comprising: a first user-selectable button having associated text therein that includes “Find File to Attach” ...; a list to display selected one or more files to attach ...; and a second user-selectable button having associated text therein that includes “Attach Files”, ... wherein the first user-selectable button, the list, and the second user-selectable button are presented together to the user in the GUI,” as particularly recited in claim 27. (Emphasis added). As discussed above, Mustek does not disclose wherein the first user-selectable button, the list, and the second user-selectable button are presented together to the user in the GUI. Mustek, by contrast, displays the “Make an Attachment” button in a “Compose Mail” screen, and subsequently displays Attachments 1, 2, and 3 and the “Attach” button in a separate Attachment window after the “Make an Attachment” button is clicked. There is no disclosure or suggestion of presenting the “Make an Attachment” button, Attachments 1, 2, and 3, and the “Attach” button together to the user in the GUI.

Also as discussed above, Eudora does not rectify this deficiency in Mustek. Eudora's "Attach Document" and "Attach" buttons are not presented together to the user in the GUI. Moreover, Eudora does not disclose or suggest a list to display selected one or more files to attach. Therefore, Eudora also does not disclose or suggest wherein the first user-selectable button, the list, and the second user-selectable button are presented together to the user in the GUI, as particularly recited in claim 27.

In addition, the Mustek-Eudora combination further fails to teach or suggest a first user-selectable button having associated text therein that includes "Find File to Attach" or a second user-selectable button having associated text therein that includes "Attach Files", as recited in claim 27. (Emphasis added).

Consequently, the Mustek-Eudora combination fails to teach or suggest the combination particularly recited in claim 27. Applicant further respectfully requests the Examiner to withdraw the rejection of dependent claims 64 and 65 based at least on their dependencies, whether direct or indirect, from independent claim 27.

In view of the foregoing, Applicant respectfully requests the Examiner to withdraw the rejection pursuant to 35 U.S.C. § 103(a) of claims 27, 64, and 65.

Claims 28-31, 33, 35, 36, 38, 40, 41, 43, 45, 47, 49-55, 66, and 67

In rejecting independent claim 28, the Office has stated (on page 5 of the Office Action) that "claims 27 and 28 are similar in scope to that of claim 1 and are therefore rejected under similar rationale." Applicant traverses this rejection. The Mustek-Eudora combination fails to teach or suggest "providing a first user-selectable button having associated text that includes a verbal of "attach" via a graphical user interface (GUI) ...; displaying a list of one or more files to attach ...; providing a second user-selectable button having associated text that includes an imperative for "attach" via the GUI; and ... wherein the first user-selectable button, the list, and the second user-selectable button are presented together to the user in the GUI," as particularly recited in claim 28. (Emphasis added). As discussed above, Mustek does not disclose wherein the first user-selectable button, the list, and the second user-selectable button are presented together to the user in the GUI. Mustek, by contrast, displays the "Make an Attachment" button in a "Compose Mail" screen, and subsequently displays Attachments 1, 2, and 3 and the "Attach"

button in the separate Attachment window after the “Make an Attachment” button is clicked. There is no disclosure or suggestion of presenting the “Make an Attachment” button, Attachments 1, 2, and 3, and the “Attach” button together to the user in the GUI.

Also as discussed above, Eudora does not rectify this deficiency in Mustek. Eudora’s “Attach Document” and “Attach” buttons are not presented together to the user in the GUI. Moreover, Eudora does not disclose or suggest a list to display selected one or more files to attach. Therefore, Eudora also does not disclose or suggest wherein the first user-selectable button, the list, and the second user-selectable button are presented together to the user in the GUI, as particularly recited in claim 28.

In view of the foregoing, Applicant respectfully requests the Examiner to withdraw the rejection pursuant to 35 U.S.C. § 103(a) of independent claim 28. Applicant further respectfully requests the Examiner to withdraw the rejection of dependent claims 29-31, 33, 35, 36, 38, 40, 41, 43, 45, 47, 49-55, 66, and 67 based at least on their dependencies, whether direct or indirect, from independent claim 28.

#### Claim 56

In rejecting independent claim 56, the Office has stated (on page 6 of the Office Action) that “claim 56 is similar in scope to that of claim 27 and is therefore rejected under similar rationale.” As noted above, the Office has stated (on page 5 of the Office Action) that “claims 27 and 28 are similar in scope to that of claim 1 and are therefore rejected under similar rationale.” Applicant traverses the rejection of claim 56. The Mustek-Eudora combination fails to teach or suggest instructions causing the machine to: provide a first user-selectable button having associated text that includes a verbal of “attach” via a graphical user interface (GUI); ... display a list of one or more files to attach to the electronic message ...; provide a second user-selectable button having associated text that includes an imperative for “attach” via the GUI; and ... wherein the first user-selectable button, the list, and the second user-selectable button are presented together to the user in the GUI, as in claim 56. As discussed above, Mustek does not disclose that the first user-selectable button, the list, and the second user-selectable button are presented together to the user in the GUI. Mustek, by contrast, displays the “Make an Attachment” button in a “Compose Mail” screen, and subsequently displays Attachments 1, 2,

and 3 and the “Attach” button in the separate Attachment window after the “Make an Attachment” button is clicked. There is no disclosure or suggestion of presenting the “Make an Attachment” button, Attachments 1, 2, and 3, and the “Attach” button together to the user in the GUI.

Also as discussed above, Eudora does not rectify this deficiency in Mustek. Eudora’s “Attach Document” and “Attach” buttons are not presented together to the user in the GUI. Moreover, Eudora does not disclose or suggest a list to display selected one or more files to attach. Therefore, Eudora also does not disclose or suggest wherein the first user-selectable button, the list, and the second user-selectable button are presented together to the user in the GUI, as particularly recited in claim 56.

In view of the foregoing, Applicant respectfully requests the Examiner to withdraw the rejection pursuant to 35 U.S.C. § 103(a) of independent claim 56.

**CONCLUSION**

Applicant has pointed out specific features of the claims not disclosed, suggested, or rendered obvious by the references applied in the Office Action. Accordingly, Applicant respectfully requests reconsideration and withdrawal of each of the objections and rejections, as well as an indication of the allowability of each of the pending claims.

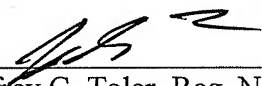
Any changes to the claims in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

The Examiner is invited to contact the undersigned attorney at the telephone number listed below if such a call would in any way facilitate allowance of this application.

The Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

8-19-2008  
Date

  
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